

PATENT
Docket No. 559442002000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of:
Jeffrey M. HARRINGTON

Confirmation No. 8579

Application No.: 09/397,298

Art Unit: 2178

Filed: September 15, 1999

Examiner: T. V. Huynh

For: ENHANCED VIDEO PROGRAMMING
SYSTEM AND METHOD UTILIZING A WEB
PAGE STAGING AREA

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Washington, D.C. 22313-1450

Sir:

This is a timely appeal from the final rejection of claims 1-21 and 23-30 in the Office Action mailed March 11, 2005.

I. REAL PARTY IN INTEREST

The real party in interest is ACTV, Inc.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences within the meaning of 37 CFR 41.37(c)(1)(ii) known to appellant, the appellant's legal representative, or assignee.

III. STATUS OF CLAIMS

Claims 1-21, 23-30, and 71-127 are pending in this application. Claims 71-127 have been withdrawn from consideration. Independent claims 1 and 17 are finally rejected under 35 USC 103(a) as being unpatentable over the combination Hidary, Wu, Mighdoll, Schaffa, and Hills. The rejection of claims 1-21 and 23-30 is being appealed. The appealed claims

are reproduced in the attached Appendix.

09/14/2005 MBENYEN1 00000031 031952 09397298

02 FC:1402

500.00 DA

IV. STATUS OF AMENDMENTS

No amendment after final rejection has been filed.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claims 1 and 17 are directed to receiving a pre-fetch command to retrieve a web page and constructing the web page in a hidden staging frame prior to display on the display device.

The specification describes that by synchronizing specific Internet pages to a video signal, television program producers can decide what additional information to offer the audience in the context of the television program. (Page 3, lines 15-18.) To provide a more television-like viewing experience, the specification further describes that a web-page staging area can be used on a client machine to construct a web page hidden from view. (Page 7, lines 14-16.) Thus, the viewer will not be required to wait while a web page is progressively downloaded and displayed in a piecemeal fashion.

The specification describes that the client machine can receive a pre-fetch push command, a URL, and timer event information from a server. A server can transmit a pre-fetch push command with an address and optional timer event information to a browser plugin. The pre-fetch command is used to obtain and assemble content, such as a web page, prior to presentation on an client machine. (Page 29, lines 6-9.)

A hidden staging frame can be set up in memory for constructing the web page. Content can be retrieved and the web page constructed in the hidden staging frame. (Page 7, lines 7-16.) As the web browser retrieves content, it constructs a web page hidden from view in a hidden staging frame. (Page 30, lines 4-5.) The specification describes that a web browser can use a portion of memory reserved for constructing web pages hidden from view (page 28, lines 8-9) and that multiple hidden staging frames may be used (page 30, lines 8-14).

The specification further describes that as the browser retrieves the content, it constructs the web page in hidden staging frame so that the user does not view the web page being constructed. The construction involves retrieving and locally compiling content for the

page for presentation of page when completed. For presentation of the page in a web browser on a computer display, the construction involves assembling the content for display in the browser. (Page 31, line 18 – p. 32, line 1.)

After the web page is constructed and, in some embodiments, after the timer expires or other relevant timer event occurs, a web browser can retrieve the constructed web page and display it to the user. (Page 7, lines 7-16.) In some embodiments, the actual retrieved web pages referenced by the URL can be optionally time stamped to be displayed on the computer screen when predetermined related video content is displayed in the video window. (Page 16, lines 12-15.) In response to a timer event or a show command, the web browser retrieves the constructed web page from the hidden staging frame and displays the web page. (Page 30, lines 8-14.)

The specification further describes that web pages can be synchronized with particular video frames and presented to the user. (Page 20, lines 2-3.) For example, the timer event information can be used to trigger display of a web page for an advertisement at the same time as corresponding information is provided by the video programming. (Page. 27, lines 20-22.) The specification also describes that a particular command can be used to cause display of a constructed web page. (Page 27, lines 14-15.)

The specification provides several examples of uses of a web page staging area. One example in the context of a sporting event is described at page 33, line 10 - page 34, line 4. In this example, a producer of a professional football game can push a JAVA applet from a server to a user's web page staging area in the user's machine. The producer can also push a Javascript timer so that the JAVA applet can be launched at a precise time such as the start of a football game. The producer could also send a fumble graphic to the user's machine in another hidden frame. Because the producer does not know, at the time of transmission, when the graphic should be shown, no timer would be included. Rather, after a player fumbles, the producer can send a command to the web page staging area to immediately display the fumble graphic in a web browser on the client machine.

In this manner, the invention is able to format and integrate multimedia content in a live programming environment where the time available to retrieve information and construct a web page is greatly reduced.

VI. GROUNDΣ OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-21 and 23-30 stand finally rejected under 35 USC 103(a) as being unpatentable over Hidary, Wu, Mighdoll, Schaffa, and Hills.

VII. ARGUMENT

The rejection of claims 1-21 and 23-30 under 35 USC 103(a) should be reversed.

Claim 1 recites “constructing the web page in a hidden staging frame prior to display on the display device in order to produce the constructed web page.” As discussed in more detail below, Appellant submits that none of the cited references disclose the claimed feature of constructing a web page prior to display, none of the cited references disclose using a hidden frame to construct a web page, and that there is no motivation to combine the cited references. Appellant therefore respectfully requests that the rejection of claims 1-21 and 23-30 be reversed.

A. Hidary does not disclose constructing a web page prior to display.

The Examiner stated at page 3 of the final Action that Hidary teaches “constructing the web page prior to display on the display device in order to produce the constructed web page.” In support of the rejection, the Examiner cited Hidary at col. 3, lines 26-38; col. 4, lines 28-56; and col. 5, lines 32-46.

As discussed above, the specification describes that “[a]s the browser...retrieves the content, it constructs the web page...in hidden staging frame...so that the user does not view the web page being constructed. The construction involves retrieving and locally compiling content for the page for presentation of page when completed. For presentation of the page in a web browser on a computer display, the construction involves assembling the content for display in the browser.” (Page 31, line 18 – p. 32, line 1, emphasis added)

Appellant submits that there is no disclosure in Hidary of constructing a web page prior to display. The portions of Hidary cited by the Examiner disclose only the use of a

vertical blanking interval (VBI) to deliver web page addresses and time stamping URLs to indicate a display time for a web page. Hidary at col. 3, lines 26-38, discloses that a system synchronizes a web page to a video signal and, at the appropriate time, presents the web page. Hidary at col. 4, lines 28-56, discloses that a URL embedded into the video programming can have an associated time stamp that indicates when, during the program, the web page is to be displayed. Hidary at col. 5, lines 32-46, discloses that URLs can be encoded into the VBI. Nowhere in these cited portions is there even a suggestion of retrieving and locally compiling content for the page for subsequent of the page.

Appellant therefore submits that the Examiner has not identified any disclosure of a structure or function in Hidary that teaches the claimed feature of “constructing the web page...prior to display.”

B. Constructing a web page prior to display on a display is not inherent in Hidary.

The Examiner stated at page 4 of the final Action that Hidary “inherently discloses that the web page must be constructed, such as mapping of web page content to a portion of the screen prior to display the constructed web page with the television video signal.” Appellant submits that the Examiner has failed to show that the claimed features are inherent in Hidary.

Appellant submits that Hidary teaches a system that displays a web page associated with video programs to a user. The system of Hidary clearly does not require that the web pages be constructed prior to display.

The Board of Patent Appeals and Interferences has made it clear that “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). (See also MPEP 2112 IV.)

The Federal Circuit has also described the evidentiary burden that must be met by the Examiner. “To establish inherency, the extrinsic evidence ‘must make clear that the missing

descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). “The mere fact that a certain thing may result from a given set of circumstances is not sufficient [to establish inherency.]” *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). “Inherency...may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

Appellant respectfully submits that the Examiner has not shown that the claimed features are necessarily present in Hidary. Specifically, the Examiner has not provided any evidence that, in Hidary, a web page must be constructed prior to display and that it cannot be progressively downloaded and displayed to a user in a piecemeal fashion. Thus, the Examiner has not shown that the claimed feature of constructing a web page prior to display is inherent in the system taught by Hidary.

C. Wu does not teach constructing a web page prior to display.

In the final Action at page 4, the Examiner stated that “Wu teaches...layout information instructing client machine to construct the web page prior to display.” The Examiner cited Wu at col. 2, line 66 - col. 3, line 20; col. 4, lines 19-39; col. 7, lines 21-54; and col. 11, lines 45-55. The portions of Wu cited by the Examiner teach downloading electronic program schedule information, determining a matching web address, using a server to provide a web page, and mapping user interest profiles. There is not even a suggestion of constructing a web page prior to display nor is there a suggestion of retrieving and locally compiling content for the page for presentation of page when completed.

Because neither Wu nor any of the other cited references disclose constructing a web page prior to display and this feature is not inherent in the cited references, Appellant respectfully requests that the rejection of claims 1-21 and 23-30 be reversed.

D. Hills does not disclose using a hidden frame to construct a web page.

The Examiner acknowledged at page 4 of the final Action that “Hidary does not explicitly disclose a hidden staging frame and a pre-fetch push command.” At page 5 of the Action, the Examiner stated that “Hills teaches using a hidden frame to populate data into a display frame of a web page.” Appellant recognizes that Hills teaches first retrieving data into a “hidden scroll frame” and then populating a display frame with that data. (Col. 3, lines 43-48.) However, Appellant submits that Hills does not teach “constructing a web page” in the hidden scroll frame prior to display.

Appellant submits that Hills teaches the use of a “scroll frame” simply as a buffer area and that a web page is not constructed in Hills’ scroll frame. The description in Hills makes it clear that the frames disclosed in Hills operate as buffers. Hill teaches that “[i]f the request was a scroll, at 124, the application obtains the appropriate data from the associated database. Then, at 128, the application sends the data into the hidden scroll frame...At 132, per instructions from the application, the user's browser populates the data from the scroll frame into the display frame without refreshing the entire screen.” (Col. 4, lines 37-54.) Thus, Hills teaches using the scroll frame as a source of additional data to incrementally update a screen already displayed to a user. There is no suggestion in Hills that a web page is constructed in the scroll buffer.

Furthermore, there is no teaching in Hills that the scroll frame can ever contain content corresponding to a web page. Hills teaches that “[b]y first retrieving the data into the hidden scroll frame and then populating the display frame, the invention can allow a user to scroll through data on a remote database without the need to refresh the entire visible display frame” (Col. 3, lines 43-47) and “per instructions from the application, the user's browser populates the data from the scroll frame into the display frame without refreshing the entire screen” (Col. 4, lines 52-55). The advantage of such a system is described in the Summary of the Invention of Hills. “If a user desires to scroll through records on the database, the database control application need only send the new data and instructions for the end-user to populate the data into the display frame, without the need to rebuild an entire HTML page.

Furthermore, since the data is populated from the hidden scroll frame, the end-user does not need to refresh the screen.”

Appellant therefore submits that Hills does not teach using a hidden staging frame for constructing a web page. Rather, the hidden staging area of Hills is a simple buffer. As noted above, the Examiner stated at page 5 of the Action that “Hills teaches using a hidden frame to populate data into a display frame.” There is no disclosure in Hills of any compilation of a completed page and no disclosure of retrieving and locally compiling content for the page for presentation of page when completed. Thus, Hills does not disclose, and the Examiner does not appear to suggest that Hills discloses “constructing the web page in a hidden staging frame.”

Because none of the cited references disclose using a hidden frame to construct a web page, Appellant respectfully requests that the rejection of claims 1-21 and 23-30 be reversed.

E. Motivation to Combine

Appellant respectfully submits that because none of the references show constructing a web page prior to display or the use of a hidden staging frame for constructing a web page, no combination of references can possibly show these claimed features. There can be no motivation to combine two references where neither reference discloses the claimed features.

The Examiner stated at page 5 of the final Action that “[i]t would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Hills into Hidary to provide a hidden frame for constructing the web page, since the combination would have populated the data into a display frame without rebuild an entire HTML page and/or refresh the screen as Hill suggested in col. 2, lines 15-21.” Appellant further submits that the motivation to combine the references provided by the Examiner is insufficient. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) citing *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

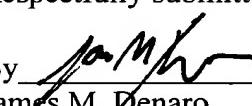
Hills is directed to accessing a remote database though a web browser client. Hills further teaches a means for efficiently retrieving small amounts of additional data from a local buffer and scrolling a screen image to display that additional data. Hidary is directed to integrating Internet content into video programming. Appellant submits that the Examiner has not identified any reason why someone in the field of integrating Internet content into video programming would look to the database buffering art. In support of the motivation to combine, the Examiner only restated the teaching of Hills - displaying content without the need to rebuild an entire HTML page and/or refresh an entire screen. Appellant submits that the Examiner has failed to identify any reason in the references themselves why someone in the field of integrating Internet content into video programming would incorporate teachings from the field of database buffering systems. None of the problems addressed by Hill are relevant to Hidary.

For the reasons above, Appellant respectfully requests that the rejection of claims 1-21 and 23-30 be reversed.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, Appellant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 559442002000.

Dated: September 12, 2005

Respectfully submitted,

By 
James M. Denaro
Registration No.: 54,063
MORRISON & FOERSTER LLP
1650 Tysons Blvd, Suite 300
McLean, Virginia 22102
(703) 760-7739

APPENDIX OF APPEALED CLAIMS

1. A method of constructing a web page and presenting the constructed web page on a display device comprising:

displaying an audio-visual program;

receiving a pre-fetch push command to retrieve the web page, including an address for use in retrieving information to construct the web page;

retrieving the information using the address;

constructing the web page in a hidden staging frame prior to display on the display device in order to produce the constructed web page;

and commanding the constructed web page be displayed on the display device based upon timer event information transmitted with the pre-fetch push command or a show command,

and wherein the web page is related to the audio-visual program.

2. A method of constructing a web page as described in claim 1 wherein the receiving step comprises receiving timer event information providing an indication of when to command the web page be displayed on the display device, and the commanding step comprises commanding the constructed web page be displayed based upon the timer event information.

3. A method of constructing a web page as described in claim 1 wherein the step of commanding further comprises the step of receiving a show command instructing that the constructed web page be displayed.

4. A method of constructing a web page as described in claim 1 wherein the address comprises a uniform resource identifier.

5. A method of constructing a web page as described in claim 2 wherein the timer event information comprises a particular amount of time after receiving the pre-fetch push command at the expiration of which a trigger is generated to actuate the commanding step.

6. A method of constructing a web page as described in claim 2 wherein the constructed timer event information comprises a particular time at which a trigger is generated to actuate the commanding step.

7. A method of constructing a web page as described in claim 1 wherein the constructing step comprises constructing the web page in a memory module.

8. A method of constructing a web page as described in claim 1 wherein the retrieving step comprises using a web browser to retrieve the information.

9. A method of constructing a web page as described in claim 3 wherein the step of receiving a command comprises receiving a program concurrent with receipt of the command instructing that the constructed web page be displayed.

10. A method of constructing a web page as described in claim 9 wherein the program comprises a video program, audio program, or multimedia program.

11. A method of constructing a web page as described in claim 9 wherein the commanding step further comprises the step of transmitting the program and the constructed web page to the display device for simultaneous display.

12. A method of constructing a web page as described in claim 11 wherein the display device is a television.

13. A method of constructing a web page as described in claim 9 wherein the commanding step further comprises the step of transmitting the program for display on a television and transmitting the constructed web page for display on the display device.

14. A method of constructing a web page as described in claim 11 wherein the transmitting step transmits the constructed web page for display to be overlaid on at least a portion of the display of the program.

15. A method of constructing a web page as described in claim 1 wherein the receiving, retrieving, constructing, and commanding steps are performed by a personal computer, a television, a cable box, a satellite box, a radio, a telephone, a telephone answering device, a wireless telephone device, a wireless Internet device, a telephone device for the deaf, or a personal digital assistant.

16. A method of constructing a web page as described in claim 1 wherein the retrieving step comprises retrieving advertising, sports, or music content.

17. An apparatus for constructing a web page and presenting the constructed web page on a display device comprising:

a display for displaying an audio-visual program;

a receiver module for receiving a pre-fetch push command to retrieve the web page, including an address for use in retrieving information to construct the web page;

a retrieving module for retrieving the information using the address;

a construction module for constructing the web page in a hidden staging frame prior to its display on the display device in order to produce the constructed web page; and

a display generation module for displaying the constructed web page on the display device based upon timer event information transmitted with the pre-fetch push command or a show command,

and wherein the web page is related to the audio-visual program.

18. An apparatus for constructing a web page as described in claim 17 further comprising a timer event module for receiving timer event information and providing an indication of when to trigger the release of the constructed web page for display on the display device, and wherein the display generation module displays the constructed web page based upon the trigger.

19. An apparatus for constructing a web page as described in claim 17 wherein the receiver receives a show command instructing the apparatus to display the constructed web page.

20. An apparatus for constructing a web page as described in claim 17 wherein the address comprises a uniform resource identifier.
21. An apparatus for constructing a web page as described in claim 18 wherein the timer event information comprises a particular amount of time after receiving the pre-fetch push command at the expiration of which the timer event module triggers the display generation module to display the constructed web page.
23. An apparatus for constructing a web page as described in claim 17 further comprising a memory for storing the constructed web page prior to its display on the display device.
24. An apparatus for constructing a web page as described in claim 17 wherein the retrieving module further comprises a computer readable program code means comprising a web browser program to retrieve the information.
25. An apparatus for constructing a web page as described in claim 19 wherein the receiver module receives a program concurrent with receipt of the command that the constructed web page be displayed.
26. An apparatus for constructing a web page as described in claim 25 wherein the program comprises a video program, audio program, or multimedia program.
27. An apparatus for constructing a web page as described in claim 25 wherein the display generation module displays the program and the constructed web page simultaneously on the display device.
28. An apparatus for constructing a web page as described in claim 27 wherein the display device is a television.
29. An apparatus for constructing a web page as described in claim 25 wherein the display generation module displays the program on a television and displays the constructed web page on the display device.

30. An apparatus for constructing a web page as described in claim 27 wherein the display generation module displays the constructed web page by overlaying it on at least a portion of the display of the program.

EVIDENCE APPENDIX

[NONE.]

RELATED PROCEEDINGS APPENDIX

[NONE.]